

REMARKS

Claims 1-28 stand rejected. Claims 7, 9, 10, and 12 have been amended to correct typographical errors. New Claims 29-40 have been added to claim additional aspects of Applicant's invention. Claims 1-39 are presently pending. The amended and newly added claims are supported in the original disclosure. No new matter has been added. In view of the foregoing amendments and the following remarks, Applicant respectfully submits that all of the presently pending claims are allowable. Reconsideration of the Application is respectfully requested.

1. Rejection of Claims 9, 10, and 12 (35 U.S.C. § 112)

The amendment corrects typographical errors in claim 7, 9, 10, and 12, which should moot the rejection. No change in claim scope or surrender of claimed subject matter is intended by the amendments.

2. Rejection of Claims 1-7 and 9-28 (35 U.S.C. § 103(a))

Claims 1-7 and 9-28 stand rejected under 35 U.S.C. § 103(a), the Examiner alleging they are unpatentable over U.S. Patent No. 5,439,406 ("Fuwa") in view of U.S. Patent No. 3,829,655 ("Thibault") and U.S. Patent No. 4,389,438 ("Ohtsuki"). Applicant respectfully submits that none of the cited references or their combinations render any of Claims 1-7 and 9-28 obvious, for at least the following reasons.

Claim 1 of the present application recites "a heating layer configured to heat a touch screen adhered to a monitor". To establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a), the proposed combination of prior art references must teach or suggest all the claim limitations. M.P.E.P. § 2143.03. Applicant respectfully submits that none of the cited references

teaches or suggests the recited "heating layer configured to heat a touch screen adhered to a

monitor.” as recited in Applicant’s claim 1.

Fuwa generally describes a method for peeling a safety panel bonded to a front surface panel of a cathode ray tube (CRT). Fuwa uses temperatures which may be destructive to the underlying monitor, which scrapped. The safety panel in Fuwa is a mechanically strong glass safety panel which is relatively heat resistant. The surface of the safety panel is rapidly heated by an infrared heater so that the resin layer bonding the panel to the CRT is heated to its melting point. Thibault generally describes an electrical heating envelope including a layer of resilient insulating material interposed between the heating plate and the vessel to be heated. Ohtsuki generally describes a process for preparing laminates including a heat treatment. None of the references, alone or in combination teach or suggest a heating layer configured to heat a touch screen adhered to a monitor.

In the Office Action, the Examiner alleges that “Fuwa et al. shows the method and apparatus for removing a front panel from a cathode ray tube (crt)” (page 2). In fact, Fuwa et al. general describe a method for peeling a *safety panel* bonded to a front surface of a CRT. The safety panel is a glass layer (col.6, lines 31-32) bonded to the CRT for anti-explosion protection (col.1, line 16). The main features of the safety panel are the mechanical strength of the panel material and of the bonding adhesive. This very strength poses a significant problem to someone who may want to remove the safety panel from the screen. For example, one of the previously known methods involved forcibly wedging a metal wire between the panel and the CRT, and using the wire to detach the panel from the CRT by brute force (col.1, lines 25-32). Applicant respectfully submits that removing the safety panel from a CRT , as described in Fuwa, does not fairly teach or suggest the removal of a touch screen adhered to a monitor. A heater for this purpose can not be said to be configured to heat a touch screen.

Moreover, Applicant respectfully submits that the proposed combination of references does not render Applicant’s claim 1 obvious because none of the references are analogous. To rely on a reference under 35 U.S.C. 103, it must be in an analogous art. See MPEP 2141.01. MPEP 2141.01(a) makes clear the requirement that ALL art used in a Section 103 rejection

must be analogous to Applicant's claimed invention.

The examiner must determine what is "analogous prior art" for the purpose of analyzing the obviousness of the subject matter at issue. "In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992).

MPEP 2141.01(a). Applicant respectfully submits that none of the cite references are in Applicant's field of endeavor – the repair of monitors with touch screens. Thibault and Ohtsuki do not deal with monitors, repairs, or salvage at all. Moreover, none of the references would reasonably suggest themselves to an ordinary artisan attempting to solve Applicant's problem.

The problem of removing a touch screen from a monitor is entirely different problem from the problem of removing a safety panel, and therefore is a problem which must be approached anew. The base reference of Fuwa is entirely unsuitable for this purpose, and its use as described may destroy the monitor, due to the substantial structural and mechanical differences between the touch screen and the safety panel. Thibault and Ohtsuki also do not address the problem of touch screen removal; in fact they do not address anything related to monitor or screen repair at all, or even the repair of any type of article. Because the references are not analogous there is no prima facie case of obviousness.

Moreover, Applicant respectfully submits that the Examiner has failed to make out another essential element of a prima facie case of obviousness, a motivation to combine the references. To reject, the Examiner must find a suggestion to combine the references that is "clear and particular". *In re Dembiczak*, 50 U.S.P.Q.2d 1614 (Fed. Cir. 1999). The requirement is for "actual evidence" of the proposed motivation to combine. *Teleflex, Inc. v. Ficosa North America Corp.*, 299 F.3d 1313, 1334, 63 USPQ2d 1374 (Fed. Cir. 2002). The Examiner claims that Ohtsuki teaches that infrared and conductive heating "are interchangeable for activating thermal adhesives in a laminate". Ohtsuki et al. generally describe a method including a heat treatment that "may be effected by conduction heating . . .

, infrared ray irradiation, blowing of heated gases, induction heating or a combination of at least two of the aforesaid heating means” (col.6, line 66, to col.7, line 2). However, what works in one application (the fabrication of a flexible laminate for packaging foods) may not work in others. The disclosure of Ohtsuki et al. refers to the *activation* of an adhesive and not to its *softening* for purposes of removal; and in a field which is quite different from the one under consideration in this application. In general, one cannot arbitrarily exchange one heating method for another and reasonably expect to obtain the same result. On the contrary, even substituting similar methods may lead to dramatic changes in the result (as for example when substituting steaming for baking in a culinary recipe). Ohtsuki does not describe, and can not be fairly read to teach that one should combine Fuwa and Thibault in order to remove touch screens adhered to monitors. Applicant respectfully submits that the Examiner is engaged in a hindsight reconstruction, and has not identified a proper motivation in the prior art to combine elements to arrive at Applicant’s claimed invention.

Applicant therefore submits, for at least all the above reasons, that Fuwa , Thibault and Ohtsuki or their combinations all fail to teach or suggest the claimed subject matter of Claims 1, and respectfully requests the withdrawal of the rejection of claim 1.

Independent claim 13 recites “means to heat a touch screen adhered to a monitor”. Claim Independent claim 24 recites “a heating layer configured to heat a touch screen”. These claims should be allowable for at least reasons similar to those given above for independent claim 1.

Claims 2-12, 14, and 25-28 depend from claims 1, 13, and 24 and thus should be allowable for at least the reasons given above for their respective parent claims.

Claim 2 also should be allowable for separate and independent reasons. Claim 2 recites a device “wherein the heating layer is configured to be placed in direct contact with the touch screen.” The Examiner admits that the base reference, Fuwa describe only a method using radiant heat. In the Office Action the Examiner alleges that Thibault shows a

device using conductive heat, and that Ohutski teaches to combine Thibault with Fuwa. In addition to the argument made above with respect to claim 1, Applicant respectfully submits that none of the references in the proposed combination teach the “direct contact” element of claim 2, and in fact the references teach away from the recited claim limitation.

Thibault and Fuwa actually teach away from the recited system with direct contact. Thibault’s device relates to the heating of the contents of vessels, for example glass vessels. Thibault generally describes a heating envelope in the shape of the vessel to be heated, including a *thermally insulating* sheet 7 (for example, of asbestos: see Thibault col. 2, lines 40-43) interposed between the heating elements and the vessel. Thibault does not disclose or suggest having a heating element in *direct contact* with the object to be heated. Fuwa identifies as one of the key advantages of their method the *lack of a contact* between the panel and the infrared heating element. This allows a “clean heating” “without smudging the surface [of the safety panel]” (col.6, lines 28-30). The structure of the apparatus described by Fuwa further supports the view that Fuwa teaches away from a heating method based on the direct contact between the surface of the panel and the heating element. Referring to Fuwa Fig.4, the CRT is moved on rails between the supply/take out position A and the heating position B. The heating elements are fixed. Therefore a clearance of about 15mm (col.5, lines 7-9) is necessary for the CRT to be moved without danger of scratching the surface of the panel and/or damaging the heating elements.

Applicant therefore respectfully submits that the Examiner’s proposed combination of references does not render Applicant’s claim 2 obvious, and respectfully requests withdrawal of the rejection. Claim 14 recites a heating device wherein “the heating means is configured to be placed in contact with the touch screen”; Claim 16 recites a method wherein “a touch screen adhered to the monitor is in contact with the heating layer”. These claims should be allowable for at least similar reasons to claim 2. Claims 17-22 being dependent on Claim 16, Applicant submits that Claims 17-22 are similarly allowable.

Claim 5 recites “a temperature controller coupled to the heating layer”. Claim 6 recites

“a temperature probe disposed in close proximity to the heating layer.” Thibault describes a temperature controller including a thermocouple “embedded in member 11 or in contact with an inner surface of metal member 11”. The presence of a thermal insulator, with an associated thermal resistance, between the thermocouple and the vessel will cause a substantial temperature differential between the two, with an associated error in the temperature regulation. Therefore Applicant submits that the limitations of Claims 5 and 6 are not found in Thibault, and Claims 5 and 6 are allowable for this reason in addition to the other reasons discussed previously. Claim 7 being dependent (as currently amended) on Claim 6, Applicant submits that Claim 7 is similarly allowable.

In the rejection of claim 9, the Examiner writes in the Office Action that “modern plastics are well known to be inexpensive, lightweight, insulating materials”. Applicant traverses the Official Notice and respectfully request that the Examiner cite a reference or provide an affidavit in support of the rejection. See MPEP § 2144.03.

Claim 20 recites “removing material remaining on the front surface of the monitor by chemically dissolving the material off of the monitor”. Applicant respectfully submits that this limitation is neither taught nor suggested by any of the cited references. Fuwa generally describes removing leftover resin with the spatula 7, by an ultrasonic rinsing process, or by steel wool and the like (col.5, lines 32-40). Fuwa et al. do not suggest or disclose a chemical process. Therefore, Applicant submits that Claim 20 is allowable for at least his reason.

Regarding Claim 24, the Examiner writes in the Office Action that “temperature probes which contact the article being heated rather than the heating layer are well known”. Applicant traverses the Official Notice and respectfully request that the Examiner cite a reference or provide an affidavit in support of the rejection. See MPEP § 2144.03.

Independent Claim 16 recites “disposing the monitor ... so that a touch screen adhered to the monitor is in contact with the heating layer” and “heating the touch screen”. This limitation is neither taught nor suggested by any of the cited references. In fact, none of

the cited references discuss touch screens at all. Moreover, as discussed above for claim 2, both Fuwa and Thibault teach away from placing an object to be heated in direct contact with a heat source.

Claims 17-23 depend from claim 16 and thus should be patentable for at least the same reasons as their parent claim 16.

For at least the foregoing reasons, Applicant submits that Claims 1-7, 9-28 are allowable and respectfully request withdrawal of all rejections.

1. Rejection of Claim 8 (35 U.S.C. § 103(a))

Claim 8 was rejected under 35 U.S.C. § 103(a), the Examiner alleging it is unpatentable over Fuwa et al., Thibault, and Ohtsuki et al., and further in view of U.S. Patent No. 4,593,752 (Tipton).

As an initial matter, Claim 8 depends from claim 1, and thus should be allowable for at least all the reasons given above for claim 1.

Separately and independently, Applicant respectfully submits that none of the references or their combinations render Claim 8 obvious, for at least the following reasons. Claim 8 recites a heating device wherein “the material of the heating layer includes silicone”.

The Examiner proposes a four-way combination to eliminate the defects of the base reference Fuwa. Applicant traverses the proposed motivation to combine the references. An ordinary artisan in the monitor repair art would not be lead to look for heater designs in food preparation – Examiner’s reconstruction is purely hindsight using Applicant’s invention as roadmap to combine four different references from four different fields. Tipton is not analogous art. Moreover, as mentioned in Section 1 above, Fuwa teaches away from the use of contact heating, which would teach away from any combination of Fuwa with Tipton.

For at least the foregoing reasons, Applicant submits that Claim 8 is allowable and respectfully request withdrawal of the rejection.

Appl. No. 10/678,238
Amendment dated October 26, 2004
Addressing Office Action of July 2, 2004

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4. New claims

New Claims 29-40 have been added to claim further aspects of Applicant's invention. All new claims are supported by the original disclosure, and no new matter has been added.

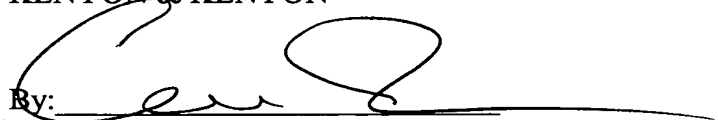
CONCLUSION

In view of the above amendments and remarks, it is respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

The Office is authorized to charge any fees associated with this Amendment to Kenyon & Kenyon Deposit Account No. 11-0600.

Respectfully Submitted,
KENYON & KENYON

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